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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,855	07/23/2001	Shoji Nakamura	04558/053001	3890
22511	7590	02/09/2005	EXAMINER	
OSHA & MAY L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010			RHEE, JANE J	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/911,855	NAKAMURA ET AL.	
	Examiner	Art Unit	
	Jane Rhee	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/9/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/14/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 22 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 22 is directed to a method of manufacturing a molded glass substrate for a magnetic disk.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 22 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The amendment filed on September 9, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. The 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows; the phrase "smoothness corresponding to glass material that does not converge on a mold face" does not appear in the disclosure". Applicant is required to cancel the new matter in reply to this office action.

New Rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter issue is an outer surface that has a smoothness corresponding to glass material that does not converge on a mold face. Applicant did not define in the specification the term "molding free face" as an outer surface that has a "smoothness corresponding to glass material that does not converge on a mold face". There is no apparent basis in the original disclosure for "smoothness corresponding to glass material that does not converge on a mold face." The new matter issue is an outer surface that has a smoothness corresponding to glass material that does not converge on a mold face. Clarification is required.

Rejections Repeated

4. The 35 U.S.C. 102(e) rejection of claim 1-5,8,21 anticipated by Takahashi et al. has been repeated for the reasons set forth in the previous office action mailed on 6/15/2004.

Regarding the newly added "smoothness corresponding to glass material that does not converge on a mold face", Since Takahashi discloses the surface roughness value of less than 0.5nm (col. 8 line 67) as desired by the applicant, it is inherent that the surface has a smoothness corresponding to glass material that does not converge on a mold face.

5. The 35 U.S.C. 103(a) rejection of claims 6-7 over Takahashi et al. over Donley et al. has been repeated for the reasons set forth in the previous office action mailed on 6/15/2004.

Response to Arguments

6. Applicant's arguments filed 9/9/2004 have been fully considered but they are not persuasive.

Applicant requested an initial copy of page 2 of the PTO 1449 form filed 10/29/01, the examiner has acknowledged the PTO 1449 and has initial the copy. Applicant also requested an acknowledgement for applicant's claimed priority under 35 U.S.C. 119 and the examiner has acknowledged the priority in the present action.

Applicant argues that Takahashi does not disclose an outer surface that has a smoothness corresponding to glass material that does not converge on a mold face, and further states in the arguments that the present invention has a surface roughness or smoothness measured at 0.047 micron which is substantially less than the prior art, because this surface is formed to have a smoothness corresponding to a glass material that does not converge on a mold face. Since Takahashi discloses the surface roughness value of less than 0.5nm (col. 8 line 67) as desired by the applicant, it is inherent that the surface has a smoothness corresponding to glass material that does not converge on a mold face.

Applicant further amended independent claim 1 with the limitation of the upper and lower principle surfaces that have a characteristic corresponding to a surface of the molding die. Applicant's invention is a magnetic disk created using a molding die, which

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has the characteristics of a substrate having a disk like shape. Takahashi et al. discloses an information recording medium comprising a substrate having a disk like shape (col. 2 lines 61-62). Therefore, Takashi et al. does disclose that the upper and lower principle surfaces have a characteristic corresponding to a surface of the molding die since the characteristic corresponding to the surface of the molding die creates a disk like shape.

Applicant also added a new claim 21 stating that the outer surface is a molding free face in the mirror-finished state. Applicant defined in his arguments that a "molding free face" has an outer surface roughness measured at 0.047 microns which is substantially less than the prior art, because this surface is formed to have a smoothness corresponding to a glass material that does not converge on a mold face. Since Takahashi discloses the surface roughness value of less than 0.5nm (col. 8 line 67) as desired by the applicant, it is inherent that the surface has a smoothness corresponding to glass material that does not converge on a mold face as discussed above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

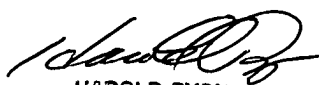
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

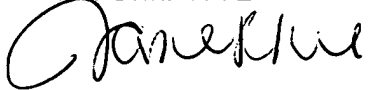

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/29/04

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A handwritten signature in black ink, appearing to read "Jane Rhee". The signature is written in a cursive, flowing style with a large initial "J".

Jane Rhee

November 17, 2004